

REMARKS

Claims 1-7, 9-16 and 18-21 are pending in the present application. Claims 8 and 17 are canceled. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, First Paragraph

The Final Office Action rejects claims 1-7, 9-16 and 18-21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

With respect to this rejection, the Final Office Action recites:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The relevant portion of the disclosure (page 13, line 20 through page 14, line 8) reads, "The tagging of the highlighted passage for searching may be initiated using a number of different mechanisms." The relevant portion of the disclosure also reads "This note also may be tagged for research in these examples."

Although "tagging is disclosed, it is not described as claimed in the invention. Specially, independent claims 1, 18, 20 and 21 recite in part wherein the user tags a beginning point and an ending point of any portion of text in the electronic book. Independent claims 11 and 19 recite in part designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document. Thus, the underlined portion does not have support in the disclosure.

Final Office Action dated December 7, 2004, pages 2-3.

Amendments were previously made to claims 1, 11, 18, 19, 20 and 21 in the Response to Office Action filed on September 24, 2004 to clarify the method for selecting a block of text from an e-book, which is a method known by one skilled in the art, and to clarify that after the electronic book is displayed, the selected text is formed by selecting any portion of the electronic book using the known method of selecting a block of text where the user tags the beginning and ending points of the text. The online encyclopedia called Webopedia describes selecting a block of text as follows: "To specify a block of text, you press special function keys (or click with a mouse) at the beginning and end of the block." on the web page located at

<http://www.webopedia.com/TERM/B/block.html>. The specification on page 13, lines 23-26, recites that "A user can highlight or select passages 424 and 428 within e-book 420, which may be researched using client search process 430." Further, other portions of the specification also support the amendments to these claims. For example on page 3, line 24 through page 4, line 4, the specification recites "Often times the user may want to perform research on topics or items presented in the e-book. E-books may contain large amounts of text. When researching information from an e-book, referring back to the portions of text that are of interest may be cumbersome and time consuming due to the size of the electronic book. This is especially true if the user has found multiple items of interest in different portions of the e-book." Additionally, the specification, on page 11, lines 9-13, recites "Client 300 also includes the processes of the present invention for viewing an e-book, highlighting or otherwise selecting a portion of text, send the text to a search engine for searching, receive the results, and present them to the user."

Additionally, the following support was added to the paragraph of the specification on page 11, lines 4-13:

For example, selecting a portion of text may be performed by tagging (such as clicking with a mouse) a beginning point and an ending point of any portion of text in the electronic book that is of interest to a user. This method of selecting text is well known in the art.

The cited portions of the specification support that a user may select any portion of the electronic book to form the selected text by selecting a block of text (i.e. tagging the beginning point and ending point of any portion of text) in the electronic book. Therefore, Applicants respectfully submit that the rejection of claims 1-7, 9-16 and 18-21 under 35 U.S.C. § 112, first paragraph has been overcome.

II. Response to Examiner's Rebuttal of Applicants' Arguments With Respect to Claims 1-7, 9-16 and 18-21

The Examiner maintains his position as set forth in the Office Action dated June 25, 2004 with regard to the rejection of claims 1-7, 9-16 and 18-21. Specifically, the Examiner maintains the rejection of claims 1-7, 9-16 and 18-21 under 35 U.S.C. § 102(e) as being allegedly anticipated by *Graham et al.* (U.S. Patent Number 6,457,026 B1), hereinafter referred to as *Graham*. These rejections of claims 1-7, 9-16 and 18-21 are

respectfully traversed for at least the same reasons as noted in the Response to Office Action filed on September 24, 2004. Thus, since these rejections have been addressed in the Response to Office Action filed on September 24, 2004, Applicants will appropriately address only the Examiner's rebuttal of Applicants' arguments set forth in the Final Response to Office Action dated December 7, 2004 in the following remarks.

With regard to Applicants' arguments filed on September 24, 2004, the Final Office Action states:

Applicant's arguments filed September 24, 2004 have been fully considered but they are not persuasive. Applicant argues that Graham does not teach or suggest every element of the claimed invention. The Applicant further specifies, Graham does not teach or suggest the "receiving" step as recited in independent claims 1, 18, 20 and 21. The Applicant further strongly argues that Graham provides no ability for a user to select a portion of a displayed electronic book, by tagging a beginning point and an end point ..."

The Examiner strongly disagrees because it is Graham who teaches tagging beginning point and an end point, or special tags around particular words or phrases (column 8, lines 13-31) not the present invention. The present invention merely describes tagging. The relevant portion of the disclosure (page 13, line 20 through page 14, line 8) reads, "The tagging of the highlighted passage for searching may be initiated using a number of different mechanisms." The relevant portion of the disclosure also reads "This not also may be tagged for research in these examples."

The Applicant also argues that Graham does not teach or suggest that a user can select any portion of text from an electronic document after the electronic document is displayed and automatically searching for items relevant to the selected text in response to the user input selecting the text. The Examiner disagrees because as given rejection above and as described in column 7, lines 26 – column 8, lines 12, Graham describes the limitation.

Final Office Action dated December 7, 2004, pages 8-9.

Claim 1, which is representative of the other rejected independent claims 18, 20 and 21 with regard to similarly recited subject matter, reads as follows:

1. A method in a data processing system for researching text in an electronic book, the method comprising:
receiving a user input selecting the text from the electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and
automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that *Graham* does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, *Graham* does not teach or suggest receiving a user input selecting the text from an electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed and automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input, as recited in independent claims 1, 18, 20 and 21.

The Final Office Action refers to the following portion of *Graham* in the rejection of independent claims 1, 18, 20 and 21:

If a concept has been selected for editing, its name appears in a concept name box 813. The portion of the belief network pertaining to the selected concept is shown in a belief network display window 814. Belief network display window 814 shows the selected concept, the subconcepts which have been defined as relating to the selected concept and the percentage values associated with each relationship. The user may add a subconcept by selecting a subconcept add button 815. The user may edit a subconcept by selecting the subconcept in belief network display window 814 and then selecting a subconcept edit button 816. A subconcept remove button 818 permits the user to delete a subconcept from the belief network.

Selecting subconcept add button 815 causes a subconcept add window 820 to appear. Subconcept add window 820 includes a subconcept name box 822 for entering the name of a new subconcept. A slider control 824 permits the user to select the percentage value that defines the probability of the selected concept appearing given that the newly selected subconcept appears. A keyword list 826 lists the keywords and key phrases which indicate discussion of the subconcept. The user adds to the list by selecting a keyword add button 828 which causes display of a dialog box (not shown) for entering the new keyword or key phrase. The user deletes a keyword or key phrase by selecting it and then selecting a

keyword delete button 830. Once the user has finished defining the new subconcept, he or she confirms the definition by selecting an OK button 832. Selection of a cancel button 834 dismisses subconcept add window 820 without affecting the belief network contents or structure. Selection of subconcept edit button 816 causes display of a window similar to subconcept add window 820 permitting redefinition of the selected subconcept.

By selecting whether a background learning checkbox 836 has been selected, the user may enable or disable the operation of profile updating stage 624. A web autofetch check box 838 permits the user to select whether or not to enable an automatic web search process. When this web search process is enabled, whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista.TM. is employed to look on the World Wide Web for documents containing the keyword or key phrase. A threshold slider control 840 is provided to enable the user to set a threshold relevance level for this autofetching process.

FIGS. 9A-9B depict a user interface for providing feedback in accordance with one embodiment of the present invention. User 504 may select any text and call up a first feedback window 902. The text may or may not have been previously identified by the annotation system as relevant. In first feedback window 902 shown in FIG. 9A, user 504 may indicate the concept to which the selected text is relevant. First feedback window 902 may not be necessary when adjusting the relevance level for a keyword or key phrase that is already a part of belief network 700. After the user selects a concept in first feedback window 902, a second feedback window 904 is displayed for selecting the degree of relevance. Second feedback window 904 in FIG. 9B provides three choices for level of relevance: good, medium (not sure), and bad. Alternatively, a slider control could be used to set the level of relevance. If the selected text is not already a keyword or key phrase in belief network 700, a new subconcept is added along with the associated new keyword or key phrase. If the selected text is already a keyword or key phrase, above, probability values within belief system 700 are modified appropriately in response to this user feedback. (emphasis added)

Graham, column 7, line 26 through column 8, line 12.

This portion of *Graham* refers to Figure 8, Figure 9A and Figure 9B. Figure 8 is a user interface for defining a user profile (see *Graham*, column 2, lines 46-48). The user interface allows concepts to be defined in a user profile. The user interface provides the method for adding, editing and removing concepts of interest in a user profile. Figure 8 of *Graham* follows:

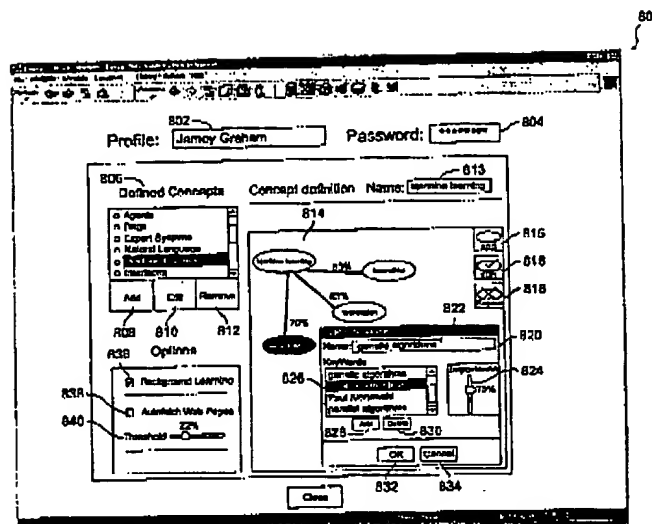


FIG. 8

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Graham, Figure 8.

Figure 8 of *Graham* shows that a user can add a concept by entering text into concept name box 813 or add a subconcept by entering text into subconcept name box 820. A list of the defined concepts are displayed in box 806. A user may select a defined concept to edit or remove from the list. *Graham* also teaches searching for web pages containing a concept. To the contrary, claims 1, 18, 20 and 21 recite receiving a user input selecting the text from an electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input. In other words, in the present invention, a user may select any portion of text in an electronic book as the user is reading the electronic book and search for items relevant to the selected text in response to selecting the text. For example, a user may be reading an electronic book and not know information about a breed of a dog, for instance. The user can select the text "Basenji puppies" by tagging the "B" in "Basenji" and the "s" in "puppies" (i.e. beginning and ending point of any portion of text in the electronic book) while reading

the electronic book and a search for items relevant to the selected text is automatically initiated. Thus, a user can find out information on "Basenji puppies", for example, while reading the electronic book. *Graham* does not teach or suggest these features as recited in claims 1, 18, 20 and 21.

Additionally, Figure 9A and Figure 9B of *Graham* show a user interface for providing feedback. A user may select text and identify the selected text as being relevant to a previously defined concept of interest. To the contrary, claims 1, 11, 18, 19, 20 and 21 recite automatically initiating a search for items relevant to the selected text in response to the user input selecting the text. Thus, *Graham* does not teach or suggest the features of claims 1, 18, 20 and 21.


In view of the above and the Response to Office Action dated September 24, 2004, Applicants respectfully submit that *Graham* does not teach each and every feature of independent claims 1, 11, 18, 19, 20 and 21, as is required under 35 U.S.C § 102(e). At least by virtue of their dependency on claims 1 and 11, respectively, *Graham* does not teach each and every feature of dependent claims 2-7, 9-10 and 12-16. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-7, 9-16 and 18-21 under 35 U.S.C § 102(e).

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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